

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:	)	Examiner: Vig, Naresh
	)	
<b>Holliman, et al.</b>	)	Art Unit: 3629
	)	
Application No.: 09/275,514	)	
	)	
Filed: March 24, 1999	)	
	)	
Conf. No.: 9862	)	
	)	
For: PARTIAL PROTECTION OF	)	
CONTENT	)	
	)	

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REPLY TO EXAMINER'S ANSWER**

Dear Sir:

Appellants respectfully reply to the Examiner's answer as follows:

(A) In "Response to Argument," pages 19-21, the Examiner responds to Section 7.1.1.1 "Official Notice" of Appellant's Appeal Brief. In Appellant's Appeal Brief, Appellant questioned the Examiner's use of "Official Notice" as a basis for rejecting claims 2 and 13 of the instant application. Appellant noted that the Examiner was not taking notice of scientific knowledge or technology but rather was taking official notice of the Examiner's own legal conclusion that the recitations (i.e., selecting the set of segments) are obvious.

In response, the Examiner states that "it is common sense that a content provider of a video has to select at least some of the set for visual scrambling." The Examiner then proceeds to explain the conclusion by noting that a "business selects

what segments [are] to be protected in order to provide for example a video recording on a medium which has parental control.”

Appellant respectfully submits that the Examiner is still simply citing a legal conclusion rather than pointing to any reference as teaching or suggesting the limitation. While basing a rejection on Official Notice of well known facts (e.g., the Earth is round) is certainly permissible, Appellant has the right to request that the Examiner provide documentary support for the finding. If the finding truly is well-known, finding documentary support should not be difficult. But as Appellant noted in the Appeal Brief, such support has previously been sought and has not been provided. Thus, claims 2 and 13 remain rejected simply on the basis of the Examiner’s conclusion that their limitations are “common sense” (i.e., obvious). Appellant submits that this is simply insufficient to establish *prima facie* obviousness, and non-compliant with the well settled body of law on legal obviousness analysis.

Appellant notes that the Examiner also tries to bolster the above-conclusion by citing Figure 11 of Lewis as showing that a medium with a video recording includes a protected (i.e., selected) segment to bolster the argument that it would be “common sense” to select the segment.

In response, Appellant notes that it would not be common sense if the segment was already selected/protected by another device. Such a selection would then be unnecessary and redundant. The mere providing of a thing is not sufficient to show that the device doing the providing also did the creating (selecting). If the Examiner is aware of description or drawings in any of the cited references that teach or suggest the limitations of claims 2 and 13, than Appellant respectfully requests that the Examiner point out the relevant passages/drawings.

(B) In “Response to Argument,” pages 21-22, the Examiner responds to Section 7.1.1.2 “Remarks” of Appellant’s Appeal Brief. In Appellant’s Appeal Brief, Appellant contended that Lewis, Hsu, and DirecTV do not teach or suggest a correct

key that is based at least in part on the identifier associated with the network address of the receiving device. Accordingly, Appellant concludes, the Examiner has failed to establish a *prima facie* case for obviousness.

In response to Appellant, the Examiner first argues that the argued limitation is not positively recited by the Appellant (the Examiner repeats this argument in numerous locations through “Response to Arguments”). Appellant respectfully disagrees. Claim 1, as appealed, recites “a correct key ... that is based at least partially on the associated identifier” (claim 1, lines 7-8) and that the associated identifier is “associated with a network address of the receiving device” (claim 1, line 2). Accordingly, Appellant is correct in asserting that claim 1 positively recites “a correct key that is based at least in part on the identifier associated with the network address of the receiving device.”

Second, the Examiner argues that DirecTV teaches “the decoding of video content based on the access card.” Appellant does not disagree with this description of DirecTV’s teachings. Rather, as Appellant argued in the Appeal Brief, decoding based on an access card simply does not teach or suggest decoding based on a common key that is based on an identifier associated with the receiver’s network address.

Third, the Examiner states that “it is common sense that using part of the network address as a key to access system is old an [sic] known to one of ordinary skill in the art.” Appellant respectfully disagree. The Examiner’s argument is conclusory, providing no citation to any portion of any reference as teaching or suggesting the contended element. Further, even if such a limitation sounds “old” and “known” now, Appellant notes that this application was filed in 1999, when such a limitation may well have not sounded “old.” Further, if the contended element is truly common sense, it should not be difficult for the Examiner to find a valid prior art reference teaching or suggesting the element.

Lastly, the Examiner provides the example of a telephone number being used to access a network as teaching the contended element. Appellant is uncertain of the relevance of this example, since it was not provided in any prior rejection. If provided as a basis for maintaining the rejection, Appellant respectfully submits that the example would necessitate a new rejection and the re-opening of prosecution. Regardless, the example fails to teach or disclose the contended element. It merely teaches that an identifier may be associated with a network. Even accepting this, the example does not even remotely suggest that the telephone number may be the basis of a “correct key” for undoing protection associated with video segments, as is recited by appealed claim 1.

(C) In “Response to Argument,” pages 22-24, the Examiner further responds to Section 7.1.1.2 “Remarks” of Appellant’s Appeal Brief. In Appellant’s Appeal Brief, Appellant noted that, if DirecTV were to implement the encoding/scrambling scheme recited by appealed claim 1, DirecTV would have to implement separate channels for each receiver, resulting in perhaps millions of bandwidth-consuming channels. Appellant concluded that, because of the undesirable bandwidth-consumption, it is unlikely that DirecTV implemented such a scheme.

In response, the Examiner noted that Appellant would suffer the same difficulty.

Appellant notes, in response, that whether or not Appellant would suffer the same difficulty is irrelevant. What is relevant is whether DirecTV teaches or suggests the contended limitation. As argued above, DirecTV certainly does not teach or suggest the contended limitation. Further, due to the undesirable consequences mentioned in Appellant’s Appeal Brief, DirecTV arguably teaches away from the contended limitation.

The Examiner also states that “it is common sense that DirecTV provides Pay Per View programming which can only be descrambled by the DirecTV settop

devices which have ordered the Pay Per View program, not all the DirecTV settop devices.”

In response, Appellant notes that, unlike a mass broadcast to millions of users of content, some of the content being scrambled, a pay per view session is initiated by a single viewer. In such a session, there would be no need to provide mixed content, some of it scrambled, as prior authorization will already have been obtained from the user. Thus, Appellant fails to see the relevancy of the example to appealed claim 1.

#### Conclusion

As Appellant has set forth in the brief, the Examiner has erred in his rejections. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
Schwabe, Williamson & Wyatt, P.C.

Date: December 17, 2007

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